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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,780	03/19/2001	Appu Rao Gopala Rao Appu Rao	148920.00005	9293

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EXAMINER	
HENDRICKS, KEITH D	
ART UNIT	**PAPER NUMBER**
1761	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/811,780	APPU RAO ET AL.	
	Examiner	Art Unit	
	Keith Hendricks	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,9,11-15,20-22 and 27-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 20-22 and 27-30* is/are rejected.

7)☒ Claim(s) *2-6,9 and 11-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 remains rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Again, the phrase "adjusting the ph value of the slurry to a range between about 6 and about 7", lacks support within the specification. This was an improper amendment, adding material to the claims which were not originally filed, and are not supported by the specification as originally filed. This adds "new matter" to the application.

Applicant's arguments filed October 03, 2003 have been fully considered but they are not persuasive. At page 9 of the response, applicants address the amendment by attempting to explain the scientific mechanism behind the meaning of the rejected phrase. However, this is neither persuasive nor relevant to the rejection. The rejection was made because the addition of the phrase "adjusting the ph value of the slurry to a range between about 6 and about 7" *does not find support* within the originally-filed specification or claims. Thus, any amount of understanding of the scientific basis of the language is irrelevant to the fact that applicant did not have possession of such a part of their invention (and claim language) at the time the application was filed.

The original claim language recited the phrase "neutralizing the pH value of the slurry", which was also previously rejected under 35 U.S.C. 112, second paragraph, because it was stated that (a) it is unclear if this means a pH absolute of 7, or if this indicates a certain "neutral range", and (b) it is unclear what one skilled in the art is to do if the pH was already at 7 (i.e. neutral), since such a neutral pH is encompassed by the claimed range of ph 5-9 at part (a) of claim 1. Applicant never attempted to address this issue, rather simply choosing to improperly add the new matter with the now-rejected phrase "adjusting the ph value of the slurry to a range between about 6 and about 7".

Suggested solution: Since the term "neutralization" is well-known in the art, and despite applicant's lack of explanation of the term for use within their claims (note that applicant's examples do

not neutralize the slurry to the neutral pH of 7), for the record, a definition of the term "neutralization" will be used as follows, taken from Grant & Hackh's Chemical Dictionary, 5th Edition:

Neutralization: *the process of making a solution neutral by adding a base to an acid solution, or an acid to an alkaline, or basic solution.*

Applicant is suggested to delete the rejected subject matter, and utilize the term "neutralizing", as originally claimed. Correction and deletion of the currently-rejected subject matter is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-22, 27 and 30 remain rejected under 35 U.S.C. 102(b) as being anticipated by Delrue.

Applicants' arguments filed October 03, 2002 have been fully considered but they are not persuasive. At page 10 of the response, applicants state "the entire process set forth and claimed is set up in such a way that 11% nitrogen is obtained in the product." This is not deemed persuasive, as applicants' product claims specifically require "8 to 8.5% nitrogen." It is unclear from where applicant derives the statement regarding 11% nitrogen.

Regarding the degree of hydrolysis and applicant's statements therefore at page 11 of the response, it is not disputed that the degree of hydrolysis of a product is dependent upon the factors recited by applicant. However, none of these factors have been addressed in applicant's claims, with regard to the product, and furthermore, it is unclear as to what hydrolysis applicant refers (proteins, carbohydrates, etc.). It is noted that, while Delrue utilized both carbohydrases and protease (papain) to hydrolyze the slurry, the DH (degree of hydrolysis) would have been expected to be the same as that of the instantly-claimed invention, with regard to the proteolytic hydrolysis by papain. In other words, applicant's claims are neither (a) commensurate in scope with the arguments presented, nor (b) limited such that they differentiate the product from that of the prior art. The specific limitations of applicant's product claims have been met by the teachings of the reference, as addressed in the rejection of record.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

** Note that the method claims are not rejected over the prior art of record, due to the amendment of claim 1 to limit the claim as "consisting of" the recited steps.

** Claims 2-6, 9 and 11-15 are objected to as being dependent upon a rejected claim. Upon proper amendment of claim 1 to overcome the rejection under 35 U.S.C. 112, first paragraph, all method claims 1-6, 9 and 11-15 would be allowable.

This is a Request for Continued Examination (RCE) of applicant's earlier application of the same serial number. All claims are drawn to the same invention claimed in the earlier application (including claim 30, which was previously presented as claim 26) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0987.

KEITH HENDRICKS
PRIMARY EXAMINER